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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/694,657

10/23/2000

Jeffrey B. Sponaugle

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05/25/2004

JEFFREY I. KAPLAN, ESQ., ET AL.
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EXAMINER

MOLINARI, MICHAEL J

ART UNIT

PAPER NUMBER

2665

2 2

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,657

Applicant(s)

SPONAUGLE ET AL.

Examiner

Michael J Molinari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-33 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-33,36,37,39,41 and 43 is/are rejected.
- 7) ☒ Claim(s) 38,40,42 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 40 is objected to because of the following informalities: In line 2 the phrase “of said” is repeated. Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-9 13-18, 20-23, 27-34, 36, 37, 39, 41, and 43 are rejected under 35

U.S.C. 102(e) as being anticipated by Weinstein et al. (U.S. Patent Application Publication US 2001/0026609 A1).

3. Referring to claim 1, Weinstein et al. disclose a computer system comprising: a storage medium (Memory, see paragraph 0082) having stored therein a plurality of programming instructions to implement a set of communication services on the computer system for generating on behalf of an offeror (Mary) client, an electronic token (Link, see paragraph 0061) representing an offer to participate in a voice call with a destination party designated by the offeror client (see paragraph 0055, lines 1-3 and see paragraph 0061) and including a telephone number or an IP address of said destination party (see paragraph 0061, note that a URL comprises an IP address),

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the electronic token to be transmitted by the offeror client in association with an electronic mail message to an offeree (John) (see paragraph 0055, lines 1-3), services for receiving on behalf of the offeror client (Mary), through a data network link (via email), a notification from the offeree denoting the offeree's acceptance of the offeror client's offer by activating said electronic token (see paragraph 0067), and services for causing, immediately (For example, if Mary sets the available times to call for any time, as shown in paragraph 0066) in response to the offeree's acceptance of the offeror client's offer (see paragraph 0009), a first voice call connection to be initiated to the destination party designated by the offeror client and a second voice call connection to be initiated to the offeree, and bridging together the two connections so as to establish a voice call between the destination party and the offeree (see paragraph 0008, lines 4-6, paragraph 0068 and Figures 8 and 9); and an execution unit (CPU, see paragraph 0082) coupled to the storage medium for executing the plurality of programming instructions.

4. Referring to claim 2, Weinstein et al. disclose that the offeree accepts the offeror client's offer by activating the electronic token (see paragraph 0061).

5. Referring to claim 3, Weinstein et al. disclose that activating the electronic token comprises selecting the electronic token with a user input device (see paragraph 0061).

6. Referring to claim 5, Weinstein et al. disclose that the electronic token comprises a URL (see paragraph 0061).

7. Referring to claim 6, Weinstein et al. disclose that the voice call comprises at least one of a circuit switched call and a packet based call (see Figure 8 and paragraph 0085).

8. Referring to claim 8, Weinstein et al. disclose that the destination party designated by the offeror client is the offeror client (see paragraph 0009).

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9. Referring to claim 9, Weinstein et al. disclose that the first and second voice calls each comprise a circuit switched call (see Figure 8 and paragraph 0085).
10. Referring to claim 13, Weinstein et al. disclose that the electronic token is generated on behalf of the offeror client based at least in part upon data provided to the computer system by the offeror client (see paragraph 0053).
11. Referring to claim 14, Weinstein et al. disclose that the telephone number or IP address of said destination party in said electronic token is obscured to prevent the offeree from identifying it (see paragraphs 0014, 0061, and 0065-0068).
12. Referring to claim 15, Weinstein et al. disclose programming instructions to implement services for receiving payment information from the offeror client in association with at least one of the first and second calls, and services for verifying the ability of the offeror client to pay an indicated amount, prior to causing the first and second voice calls to be bridged (see paragraph 0053).
13. Referring to claim 16, Weinstein et al. disclose a method comprising: transmitting by an offeror party (Mary) in association with an electronic mail message (see paragraph 0055, lines 1-3), an electronic token (Link, see paragraph 0061) representing an offer to participate in a voice call with a destination party (see paragraphs 0055 and 0061) and including an PSTN extension or a data network address of said destination party (see paragraph 0061, note that a URL is a data network address); receiving, by an offeree party (John), the electronic token representing the offer to participate in the voice call with the destination party (see paragraph 0061, line 1); receiving on behalf of the offeror party, through a data network link, a notification from the offeree denoting the offeree's acceptance of the offeror party's offer by activating said electronic

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token (see paragraph 0067); and causing, immediately (For example, if Mary sets the available times to call for any time, as shown in paragraph 0066) in response to the offeree's acceptance of the offeror client's offer (see paragraph 0009), a first voice call connection to be initiated to the destination party designated by the offeror client and a second voice call connection to be initiated to the offeree, and bridging together the two connections so as to establish a voice call between the destination party and the offeree (see paragraph 0008, lines 4-6, paragraph 0068, and Figures 8 and 9).

14. Referring to claim 17, Weinstein et al. disclose that the offeree party accepts the offer to participate in the voice call by activating the electronic token representing the offer (see paragraph 0061).

15. Referring to claim 18, Weinstein et al. disclose that activating the electronic token includes selecting the electronic token with a user input device (see paragraph 0061).

16. Referring to claim 20, Weinstein et al. disclose that the electronic token comprises a URL (see paragraph 0061).

17. Referring to claim 21, Weinstein et al. disclose that the destination party is the offeror party (see paragraph 0009).

18. Referring to claim 22, Weinstein et al. disclose that the voice call comprises at least one of a circuit switched call and a packet based call (see Figure 8 and paragraph 0085).

19. Referring to claim 23, Weinstein et al. disclose that both the first and second voice call connections are PSTN call connections (see Figure 8 and paragraph 0085).

20. Referring to claim 27, Weinstein et al. disclose that the electronic token is generated by a third party based at least in part upon data provided to the third party by the offeror party in

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association with a contractual relationship previously established between the third party and the offeror party (see paragraph 0053).

21. Referring to claim 28, Weinstein et al. disclose that the data provided to the third party by the offeror party includes said PSTN extension or data network address of the destination party (see paragraph 0057).

22. Referring to claim 29, Weinstein et al. disclose that said PSTN extension or data network address is obscured to prevent the offeree party from identifying it (see paragraphs 0014, 0061, and 0065-0068).

23. Referring to claim 30, Weinstein et al. disclose that the data provided to the third party includes billing information (see paragraph 0053).

24. Referring to claim 31, Weinstein et al. disclose that the voice call is bridged only after payment verification is received by the third party from an independent party assuring that the offeror party will pay for the cost of the call (see paragraphs 0053 and 0063).

25. Referring to claim 32, Weinstein et al. disclose a computer system comprising: a storage medium (Memory, see paragraph 0082) having stored therein a plurality of programming instructions to implement a set of communication services on the computer system for receiving on behalf of an offeror (Mary) client, through a data network link (see Figure 8), a notification from an offeree (John) denoting the offeree's acceptance of the offeror client's offer to participate in a voice call with a designated destination party (see paragraphs 0055, lines 1-3, 0061, and 0067), the offer communicated to the offeree by an electronic token (Link, see paragraph 0061) in association with an electronic mail message (see paragraph 0055, lines 1-3) and including a telephone number or an IP address of said destination party (see paragraph 0061,

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note that a URL comprises an IP address), and for causing, immediately (For example, if Mary sets the available times to call for any time, as shown in paragraph 0066) in response to the offeree's acceptance of the offeror client's offer (see paragraph 0009) by activating the electronic token (see paragraph 0061), a first voice call connection to be initiated to the destination party designated by the offeror client and a second voice call connection to be initiated to the offeree, and bridging together the two connections so as to establish a voice call between the destination party and the offeree (see paragraph 0008, lines 4-6, paragraph 0068, and Figures 8 and 9); and an execution unit coupled to the storage medium for executing the plurality of programming instructions (CPU, see paragraph 0082).

26. Referring to claim 33, Weinstein et al. disclose that the destination party is designated by the offeror (see paragraph 0053).

27. Referring to claim 36, Weinstein et al. disclose a computer system comprising: a storage medium (Memory, see paragraph 0082) having stored therein a plurality of programming instructions to implement a set of communication services on the computer system for generating on behalf of an offeror (Mary) client, an electronic token (Link, see paragraph 0061) representing an offer to participate in a voice call with a designated destination party (see paragraph 0055, lines 1-3 and see paragraph 0061) and including a telephone number or IP address of said destination party (see paragraph 0061 and note that a URL comprises an IP address), the electronic token to be transmitted to an offeree (John) in association with an electronic mail message (see paragraph 0055, lines 1-3) and services for causing, immediately (For example, if Mary sets the available times to call for any time, as shown in paragraph 0066) in response to the offeree's acceptance of the offeror client's offer (see paragraph 0009) by activating said

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electronic token (see paragraph 0061), a first voice call connection to be initiated to the destination party designated by the offeror client and a second voice call connection to be initiated to the offeree, and bridging together the two connections so as to establish a voice call between the destination party and the offeree (see paragraph 0008, lines 4-6, paragraph 0068, and Figures 8 and 9); and an execution unit coupled to the storage medium for executing the plurality of programming instructions (CPU, see paragraph 0082).

28. Referring to claim 37, Weinstein et al. disclose that said electronic token further includes a telephone number or an IP address of said offeree (see paragraph 0061; note that emails comprise both sender and destination addresses and that email addresses are IP addresses).

29. Referring to claim 39, Weinstein et al. disclose that said electronic token further includes a PSTN extension or a data network address of said offeree (see paragraph 0061; note that emails comprise both sender and destination addresses and that email addresses are IP addresses).

30. Referring to claim 41, Weinstein et al. disclose that said electronic token further includes a telephone number or an IP address of said offeree (see paragraph 0061; note that emails comprise both sender and destination addresses and that email addresses are IP addresses).

31. Referring to claim 43, Weinstein et al. disclose that said electronic token further includes a telephone number or an IP address of said offeree (see paragraph 0061; note that emails comprise both sender and destination addresses and that email addresses are IP addresses).

Claim Rejections - 35 USC § 103

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. Claims 4, 10-12, 19 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinstein et al. (U.S. Patent Application US 2001/0026609 A1).

34. Referring to claims 4 and 19, Weinstein et al. disclose that the electronic token comprises a link but differ from claims 4 and 19 in that they fail to disclose that the electronic token comprises a graphical icon. However, it is old and well known in the art to represent links as graphical icons to achieve the advantage of improving the appearance of a link. One skilled in the art would have known of representing links as graphical icons and would have recognized their advantage. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to represent the link as a graphical icon to achieve the advantage of improving the appearance of the link.

35. Referring to claims 10-12, Weinstein et al. differ from claims 10-12 in that they fail to disclose that either of the voice calls could be a packet based call instead of a circuit switched call. However, it is well known in the art to substitute a packet based call for a circuit switched call to achieve the advantage of saving money. One skilled in the art would have known of packet based voice calls and would have recognized their advantage. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate the use of packet based calls into the invention of Weinstein et al. to achieve the advantage of saving money.

36. Referring to claims 24-26, Weinstein et al. differ from claims 24-26 in that they fail to disclose that either of the voice call connections could be a VOIP call connection instead of a

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PSTN call connection. However, it is well known in the art to substitute a VOIP call connection for a PSTN call connection to achieve the advantage of saving money. One skilled in the art would have known of VOIP call connections and would have recognized their advantage. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate the use of VOIP call connections into the invention of Weinstein et al. to achieve the advantage of saving money.

Allowable Subject Matter

37. Claims 38, 40, 42, and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

38. Applicant's arguments filed 11 May 2004 have been fully considered but they are not persuasive.

39. Applicant has argued that Weinstein et al. fail to teach that the token comprises an IP address or a data network address. However, as shown in paragraph 0061, the token comprises a link, or URL. URLs comprise IP addresses.

Conclusion

40. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

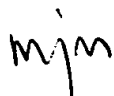
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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Molinari whose telephone number is (703) 305-5742. The examiner can normally be reached on Monday-Thursday 8am-6:30pm.

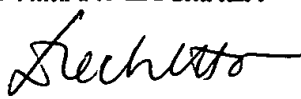
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Joseph Molinari

DUCHO
PRIMARY EXAMINER


5-24-04